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APPLICATION NO.	FILI	ING DATE	FIRST NAMED INVENTOR	ATTORNEY DO	CKET NO.	CONFIRMATION NO.
10/015,386	12	/12/2001	Kevin P. Baker	GNE.2830F	P1C55	9794
30313	7590	05/10/2004		-50	EXAM	IINER
KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET			. 1	LANDSMAN	I, ROBERT S	
FOURTEENT		ર		ART UN	IT	PAPER NUMBER
IRVINE, CA 92614			1647			

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)		
	10/015,386	BAKER ET AL.		
Office Action Summary	Examiner	Art Unit		
	Robert Landsman	1647		
The MAILING DATE of this communication ap	pears on the cover sheet with	the correspondence address		
A SHORTENED STATUTORY PERIOD FOR REPL THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1. after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a report of the period for reply is specified above, the maximum statutory period Failure to reply within the set or extended period for reply will, by statut Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b):		ly be timely filed 30) days will be considered timely. 35 from the mailing date of this communication.		
Status	•			
1) Responsive to communication(s) filed on				
	— s action is non-final.			
3) Since this application is in condition for allowa		s, prosecution as to the merits is		
closed in accordance with the practice under				
Disposition of Claims				
4) Claim(s) 28-47 is/are pending in the application	on.			
4a) Of the above claim(s) is/are withdra				
5) Claim(s) is/are allowed.				
6)⊠ Claim(s) <u>28-47</u> is/are rejected.				
7) Claim(s) is/are objected to.				
8) Claim(s) are subject to restriction and/c	or election requirement.			
Application Papers				
9)⊠ The specification is objected to by the Examine	er.			
10)⊠ The drawing(s) filed on 12 December 2001 is/a		biected to by the Examiner		
Applicant may not request that any objection to the				
Replacement drawing sheet(s) including the correct	tion is required if the drawing(s)	is objected to. See 37 CFR 1.121(d).		
11) The oath or declaration is objected to by the Ex	11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.			
Priority under 35 U.S.C. § 119				
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:	priority under 35 U.S.C. § 1	19(a)-(d) or (f).		
1. Certified copies of the priority documents have been received.				
2. Certified copies of the priority documents have been received in Application No				
3. Copies of the certified copies of the priority documents have been received in this National Stage				
application from the International Bureau (PCT Rule 17.2(a)).				
* See the attached detailed Office action for a list of the certified copies not received.				
Attachment(s)				
1) Notice of References Cited (PTO-892)	4) Interview Sum	mary (PTO-413)		
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 	Paper No(s)/M 5) Notice of Infor	ail Date nal Patent Application (PTO-152)		
Paper No(s)/Mail Date	6) Other: <u>Sequen</u>	ce Comparisons A and B.		
U.S. Patent and Trademark Office PTOL-326 (Rev. 1-04) Office Ac	tion Summary	Part of Paper No./Mail Date 050604		

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DETAILED ACTION

1. Formal Matters

- A. The Preliminary Amendment dated 12/12/01, has been entered into the record.
- B. Claims 28-47 are pending and are the subject of this Office Action.

2. Priority

Due to the excessive number of applications from which the present application claims benefit, priority cannot be determined. If Applicants are relying on a parent application in any argument, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to the present application which specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of and fully enabled for prior to 12/12/01.

3. Specification

- A. Though none could be found, due to the length of the specification, Applicants are reminded that embedded hyperlink and/or other form of browser-executable code are not permitted in the specification. See MPEP § 608.01.
- B. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title recites polypeptides and polynucleotides whereas the claims are drawn to polynucleotides.
- C. The specification is objected to since the status of application 09/380,137 should be updated to "now abandoned."

4. Claim Objections

A. The syntax of claims 28-47 could be improved by replacing the phrase "shown in Figure 130 (SEQ ID NO:227)" with "of SEQ ID NO:227" and "shown in Figure 129 (SEQ ID NO:226)" with "of SEQ ID NO:226" where appropriate.

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5. Claim Rejections - 35 USC § 112, first paragraph - enablement

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A. Claims 28-47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The deposit of the biological material is considered necessary for the enablement of the current invention (see MPEP Chapter 2400 and 37 C.F.R. §§ 1.801-1.809). Elements required for practicing a claimed invention must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If a deposit (203269) is made under the terms of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure (e.g. see 961 OG 21, 1977), and Applicants, their assignce or their agent needs to provide a declaration containing the following:

- 1. the current address of the ATCC.
- a declaration, or statement over attorney's signature stating that all restrictions imposed by the depositor on the availability to the public of the deposited biological material be irrevocably removed upon the granting of the patent (see MPEP Chapter 2410.01 and 37 C.F.R. § 1.808.
- B. Furthermore, even if a deposit under the Budapest Treaty were made, claims 28-47 would still be rejected under 35 USC 112, first paragraph, because the specification, while then being enabling for SEQ ID NO:226 and 227, does not reasonably provide enablement for polynucleotides or polypeptides having at least 80%, 85%, 90%, 95% or 99% sequence identity to SEQ ID NO:226 or 227, to the protein encoded by ATCC No. 203269, for the extracellular domain thereof, or for vectors and host cells containing these polynucleotides. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. There is no functional limitation in the claims. The claims encompass an unreasonable number of inoperative polypeptides, or polynucleotides which encode these polypeptides, which the skilled artisan would not know how to use.

There are no working examples of polynucleotides or polypeptides less than 100% identical to SEQ ID NO:226 or 227, or the mature form thereof (i.e. lacking its signal peptide). The skilled artisan would not know how to use non-identical polypeptides or polynucleotides on the basis of teachings in the

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prior art or specification unless they possessed a specific function disclosed in the instant specification, in which there is none. While the specification generally describes homologous proteins, Applicants still have not taught to which family of proteins the protein of the present invention belongs. The specification does not provide guidance for using polynucleotides encoding polypeptides related to (*i.e.*, 80%-99% identity) but not identical to SEQ ID NO:226 or 227 which do not have any specific, known function. The claims are broad because they do not require the claimed polypeptide to be identical to the disclosed sequence and because the claims have no functional limitation.

For these reasons, which include the complexity and unpredictability of the nature of the invention and art in terms of the diversity of proteins and lack of knowledge about function(s) of encompassed polypeptides structurally related to SEQ ID NO:227, or their encoding polynucleotides (e.g. SEQ ID NO:226) the lack of direction or guidance for using polypeptides that are not identical to SEQ ID NO:227, and the breadth of the claims for structure without function, it would require undue experimentation to use the invention commensurate in scope with the claims.

6. Claim Rejections - 35 USC § 112, first paragraph - written description

A. Claims 28-47 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to polynucleotides having at least 80%, 85%, 90%, 95% or 99% sequence identity with SEQ ID NO:226 as well as vectors and host cells. The claims do not require that the polynucleotides or encoded polypeptides of the present invention possess any particular biological activity, nor any particular conserved structure, or other disclosed distinguishing feature. Thus, the claims are drawn to a genus of polypeptides that is defined only by sequence identity.

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of compete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present in the claim is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

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Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See Fiers v. Revel, 25 USPQ2d 1601 at 1606 (CAFC 1993) and Amgen Inc. v. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only isolated polypeptides comprising the amino acid sequence set forth in SEQ ID NO:227, or encoded by SEQ ID NO:226, but not the full breadth of the claims, meets the written description provision of 35 U.S.C. §112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

7. Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 28-47 are vague and indefinite since it is not clear whether or not the protein encoded by the polynucleotide of the present invention is a soluble protein (e.g protease), nor is it disclosed as being expressed on a cell surface. Accordingly, the limitation that the claimed protein comprises an "extracellular domain" is indefinite, as the art does not recognize soluble proteins as having such domains. Further, if the protein had an extracellular domain, the recitation of "the extracellular

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domain"..."lacking its associated signal sequence" is indefinite as a signal sequence is not generally considered to be part of an extracellular domain, as signal sequences are cleaved from said domains in the process of secretion from the cell.

B. Claims 41-43 are vague and indefinite since the claim recites "hybridizes" without the recitation of any conditions, or recites "stringent conditions: wherein these conditions are not known. Nucleic acid molecules which hybridize under conditions of "low" stringency would not necessarily hybridize under conditions of "high" stringency. Furthermore, not all conditions of "high" or "low" stringency, for example, are the same. Therefore, it is required that Applicants amend the claims to recite the exact hybridization conditions without using indefinite phrases such as "for example" without adding new matter.

8. Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- A. Claims 28-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Lal et al. (U.S. Patent No. 5,932,442). The claims recite a polynucleotide at least 80% identical to that of SEQ ID NO:226 or encoding SEQ ID NO:227, as well as fragments (e.g. extracellular domains, with and without signal sequences) thereof. The amino acids encoding the extracellular domain of this protein are not known. The claims also recite nucleic acid molecules which hybridize to SEQ ID NO:226, or one encoding SEQ ID NO:227 as well as vectors and host cells. Lal teach a polynucleotide which is 50.8% identical to SEQ ID NO:226 (Sequence Comparison A) and which encodes the polypeptide which is 59.4% identical to SEQ ID NO:227 (Sequence Comparison B) as well as vectors and host cells (Examples IX columns 49-50). This nucleic acid molecule will hybridize to that of the present invention even under the most stringent conditions. Since the length of the extracellular domain is not known, it is believed, in the absence of evidence to the contrary, that the limitations of "at least 80%" are met.

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11. Conclusion

A. No claim is allowable.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (571) 272-0887.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D. Patent Examiner Group 1600 May 07, 2004

PATENT EXAMINER

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Sequence 73, Application US/08933750C
 ; Patent No. 5932442
   GENERAL INFORMATION:
      APPLICANT: Lal, Preeti
      APPLICANT: Hillman, Jennifer L.
     APPLICANT: Bandman, Olga
     APPLICANT: Shah, Purvi
     APPLICANT: Au-Young, Janice
     APPLICANT: Yue, Henry
     APPLICANT: Guegler, Karl J.
     APPLICANT: Corley, Neil C.
     TITLE OF INVENTION: HUMAN REGULATORY MOLECULES
     NUMBER OF SEQUENCES: 98
     CORRESPONDENCE ADDRESS:
       ADDRESSEE: Incyte Pharmaceuticals, Inc.
       STREET: 3174 Porter Drive
       CITY: Palo Alto
       STATE: CA
       COUNTRY: USA
       ZIP: 94304
     COMPUTER READABLE FORM:
       MEDIUM TYPE: Diskette
       COMPUTER: IBM Compatible
       OPERATING SYSTEM: DOS
       SOFTWARE: FastSEQ for Windows Version 2.0
     CURRENT APPLICATION DATA:
       APPLICATION NUMBER: US/08/933,750C
       FILING DATE: September 23, 1997
       CLASSIFICATION: 536
     PRIOR APPLICATION DATA:
       APPLICATION NUMBER:
       FILING DATE:
     ATTORNEY/AGENT INFORMATION:
       NAME: Billings, Lucy J.
       REGISTRATION NUMBER: 36,749
       REFERENCE/DOCKET NUMBER: PF-0356 US
     TELECOMMUNICATION INFORMATION:
       TELEPHONE: 415-855-0555
       TELEFAX: 415-845-4166
       TELEX:
   INFORMATION FOR SEQ ID NO: 73:
     SEQUENCE CHARACTERISTICS:
       LENGTH: 2028 base pairs
       TYPE: nucleic acid
       STRANDEDNESS: single
       TOPOLOGY: linear
     IMMEDIATE SOURCE:
       LIBRARY: UTRSNOT05
       CLONE: 1568361
US-08-933-750C-73
Alignment Scores:
Pred. No.:
                        1.33e-303
                                       Length:
                                                      2028
Score:
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Percent Similarity:
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                                       Conservative:
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Best Local Similarity:
                        97.04%
                                       Mismatches:
                                                      15
Query Match:
                        59.45%
                                       Indels:
DB:
                        2
                                       Gaps:
US-10-012-121A-227 (1-832) x US-08-933-750C-73 (1-2028)
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Db	548	AACCTGGGGTACATCCTGCTGGGGC		 TGCAACGGGAGATC 60)7
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Db	1508	CGGGACAAGATCTATGTCTTC 1528	

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Sequence Companison B
; Sequence 73, Application US/08933750C
; Patent No. 5932442
     CLONE: 1568361
US-08-933-750C-73
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 Best Local Similarity 98.8%; Pred. No. 0;
 Matches 2003; Conservative
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Qу
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Db	1261 GATCAAGCTCATCCCCCTGCTCTGCATCGTTTGCACCTCCGTGGTCTGGGGCTTCGCGCT 1320	0
Qу	2339 CTTCTTCTTCCAGGGACTCAGCACCTGGCAGAAAACCCCTGCAGAGTCGAGGGAGCA 2398	_
Db	1321 CTTCTTCTTCCAGGGACTCAGCACCTGGCAGAAAACCCCTGCAGAGTCGAGGGAGCA 1380	
Qy	2399 CAACCGGGACTGCATCCTCCTCGACTTCTTTGACGACCACGACATCTGGCACTTCCTCTC 2458	
Db	1381 CAACCGGGACTGCATCCTCCTCGACTTCTTTGACGACCACGACATCTGGCACTTCCTCTC 1440	
Qу	2459 CTCCATCGCCATGTTCGGGTCCTTCCTGGTGTTGCTGACACTGGATGACGACCTGGATAC 2518	
Db	1441 CTCCATCGCCATGTTCGGGTCCTTCCTGGTGTTGCTGACACTGGATGACGACCTGGATAC 1500	
Qy	2519 TGTGCAGCGGACAAGATCTATGTCTTCTAGCAGGAGCTGGGCCCTTCGCTTCACCTCAA 2578	
Db	1501 TGTGCAGCGGGACAAGATCTATGTCTTCTAGCAGGAGCTGGGCCCTTCGCTTCACCTCAA 1560	
Qy Db	2579 GGGGCCCTGAGCTCCTTTGTGTCATAGACCGGTCACTCTGTCGTGCTGTGGGGGATGAGTC 2638	
Qy	1561 GGGGCCCTGAGCTCCTTTGTGTCATAGACCGGTCACTCTGTCGTGCTGTGGGGATGAGTC 1620 2639 CCAGCACCGCTGCCCAGCACTGGATGGCAGCAGGACAGCCAGGTCTAGCTTAGGCTTGGC 2698	
Db	2633 CCAGCACCGCTGCCCAGCACTGGATGGCAGGACAGCCAGGTCTAGCTTAGGCTTGGC 2698	
Qy	2699 CTGGGACAGCCATGGGGTGGCATGGAACCTTGCAGCTGCCCTCTGCCGAGGAGCAGGCCT 2758	
Db		
Qу	2759 GCTCCCCTGGAACCCCCAGATGTTGGCCAAATTGCTGCTTTCTTCTCAGTGTTGGGGCCT 2818	
Db		
Qу	2819 TCCATGGGCCCCTGTCCTTTGGCTCTCCATTTGTCCCTTTGCAAGAGGAAGGA	
Db		
Qу	2879 GACACCCTCCCCATTTCATGCCTTGCATTTTGCCCGTCCTCCTCCCCACAATGCCCCAGC 2938	
Db		
Qy	2939 CTGGGACCTAAGGCCTCTTTTTCCTCCCATACTCCCACTCCAGGGCCTAGTCTGGGGCCT 2998	
Db		
Qy	2999 GAATCTCTGTCCTGTATCAGGGCCCCAGTTCTCTTTGGGCTGTCCCTG 3046	
Db		